

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## In re Application of:

Csaky, et al.

Application No.: 10/588,884

Patent No.: 8,039,585

Filing Date: August 9, 2006

Issue Date: October 16, 2011

For: Therapeutic Administration of the Scrambled Anti-Angiogenic Peptide C16Y

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 C.F.R. § 1.181 and 37 C.F.R. 1.183**

In response to the Decision dismissing Applicants' Request for Reconsideration of Patent Term Adjustment mailed on March 13, 2012, Applicants hereby request reconsideration and suspension of the rules, if necessary, in order to accord U.S. 8,039,585 ("the '585 patent") the proper amount of patent term adjustment ("PTA") that is due – 1393 days – based on the corrected filing date of August 9, 2006.

Applicants first requested correction of the filing date to August 9, 2006 on May 11, 2011, about one month before the Notice of Allowance of U.S. Application No. 10/588,884 ("the '884 application") issued. Had the Office acted on Applicants' request, the PTA assessment would have been automatically recalculated to reflect the total amount of Patent Office delay that occurred prior to the issuance of a first office action. But the Office ignored Applicants' initial request, and has now refused to recalculate the PTA due to the '585 patent, even though it has agreed that the filing date used to calculate the PTA was incorrect.

The Decision dismissing Applicants' Request for Reconsideration of Patent Term Adjustment asserts that the Request was untimely, because the request should have been filed prior to payment of the issue fee. Applicants note, however, that the PTA calculation set forth in the Notice of Allowance was technically correct, based on the filing date that had then been accorded to the '844 application. Applicants expected the Office to act on the Request for Corrected Filing Receipt filed shortly before the '884 application was allowed, and believed that once the proper filing date was accorded, the PTA would be recalculated to reflect the change. It

was only when the patent issued, still bearing the wrong filing date, that Applicants realized that the Office had failed to act on its Request. The Office's subsequent (post-issuance) granting of Applicants' Petition to accord the correct filing date had the technical effect of invalidating the original PTA calculation. Since Applicants Petition was filed within 2 months of the issue date, and specifically requested revision of the PTA calculation when the correct filing date was accorded, Applicants' request for PTA adjustment was timely.

Moreover, since the initial error in according a correct filing date originated in the Office, and since the Office's subsequent failure to act on Applicant's request for a corrected filing receipt led to the error in determining the appropriate PTA due to this case, the patentee respectfully submits that fairness dictates that even if Applicants failed to comply with the "letter of the law," in view of these underlying facts, it would be appropriate for the Director to suspend the rules in this instance, and accord the additional 390 days of PTA that is due the '585 patent.

This Petition is being filed within two months of March 13, 2012, the date of mailing of the Decision dismissing Applicants' original Petition, and is therefore considered timely.

### **Statement of the Facts**

On August 9, 2006, Applicants filed the '844 application as an entry into the United States National Stage of International Application No. PCT/US2004/004142. Accompanying that application was the appropriate fee, a copy of the international application, and a declaration, attached hereto as Exhibit A, signed by all three inventors. Because all the requirements of 35 U.S.C. §§ 371 (c)(1), (c)(2), and(c)(4) were fulfilled on August 9, 2006, the application should have been accorded a U.S. filing date of August 9, 2006.

On August 27, 2007, Applicants' prior counsel submitted a supplemental declaration, attached hereto as Exhibit B, merely to revise the Power of Attorney. However, based on the filing receipt mailed on February 29, 2008, attached hereto as Exhibit C, it appears that the Office incorrectly characterized that Power of Attorney as the first declaration to satisfy 35 U.S.C. §371(c)(4) and mistakenly accorded the application a filing date of August 27, 2007. This was incorrect, because the first declaration under 35 U.S.C. §371(c)(4) was properly submitted on August 9, 2006.

The first notification under 35 U.S.C. § 132 (which was in the form of a Restriction Requirement) issued on March 30, 2010 and prosecution of the application commenced. On May 11, 2011, before the application was allowed, Applicants filed a Request for Corrected Filing Receipt, attached hereto as Exhibit D, requesting that the filing date be corrected to August 9, 2006. About one month later, a Notice of Allowance was mailed, identifying an allocation of 436 days of PTA having accrued to date. Based on the filing date that had originally been accorded by the office, *i.e.*, August 27, 2007, this PTA calculation of “A delay” was technically correct, because at the time the Notice of Allowance issued, the Office had not yet acted on Applicants’ Request for Corrected Filing Receipt (the request had neither been denied nor had a corrected filing receipt issued). Applicants reasonably expected that the Office would act on their request prior to the patent issuing, and thus fully expected that the period of “A delay” would automatically be recalculated when the final calculation of PTA at the time of issue was made.

However, the Office never did act on Applicants’ Request for Corrected Filing Receipt. The ‘884 application issued as U.S. 8,039,585 on October 18, 2011, still reflecting the incorrect filing date on the face of the patent. On December 19, 2011 (within the deadline set for requesting correction of PTA following issuance of the patent), Applicants filed a Petition addressing the fact that the Office had not corrected the filing date as had been requested during prosecution. That Petition further noted that PTA should be revised once the filing date was corrected.

The Office reviewed Applicant’s Petition, agreed that the correct filing for the ‘585 patent was August 9, 2006, and on January 18, 2012 issued a corrected filing receipt, attached hereto as Exhibit E, properly reflecting the August 9, 2006 filing date. Thus, the Office has conceded that the filing date set forth in Applicants’ original Request for Corrected Filing Receipt was correct. However, on March 13, 2012 the Office dismissed the other request in Applicants’ December 19, 2011 Petition, *i.e.*, that the amount of PTA be recalculated in view of the correction of the filing date. That request was dismissed as “untimely,” alleging that since the period of Patent Office delay that Applicants sought to have corrected falls under 37 C.F.R.

1.704(b), Applicants should have filed the petition under 37 C.F.R. 1.705(b), on or before payment of the issue fee.

Notably, the Office did not dispute Applicants assertion that the '585 patent is properly due a total of 1393 days of PTA, based on its August 9, 2006 filing date. The first office action, a restriction requirement, was mailed on March 30, 2010, 909 days more than 14 months from the 371(c) completion date – August 9, 2006. There are 795 days of B delay, totaling 1704 days of PTO delay. Of those 1704 days, 228 days overlap between the A and B delays and there were 83 days of applicant delay, totaling 311 days. Subtracting 311 days from 1704 days results in a total of 1393 days of patent adjustment that should be accorded to the '585 patent.

#### **Points to be Reviewed**

The Office of Petitions has incorrectly cast Applicants' December 19, 2011 Petition solely as an untimely request for reconsideration of PTA under 37 C.F.R. 1.705(b). This is incorrect. The PTA reflected on the Notice of Allowance was based on the incorrect filing date of August 27, 2007. Using August 27, 2007 as the filing date, the PTA reflected on the Notice of Allowance was not in error. As such, Applicants *could not have* properly requested reconsideration of the PTA *until* the filing date was corrected to August 9, 2006. Applicants had already filed a request for a corrected filing receipt shortly before the Notice of Allowance issued and had every reason to believe that the Office would, in due course, take action on that request and correct its mistake. Moreover, Applicants had every reason to believe that once the filing date was corrected, the Office would automatically address all discrepancies that flowed from that mistake, including recalculating the PTA, and that this correction would be reflected in the final PTA allocation reflected on the issue notification and on the face of the patent.

Even though Applicants filed the appropriate request for a corrected filing receipt during prosecution of the application, the Office took no action until after the patent issued and after persistent telephonic inquiries by the Applicants' representatives. Now that the filing date has finally been correctly noted in the Office's records, the PTA should *automatically* be recalculated as requested in Applicants' Petition, without further action by the Applicants.

Much to the Applicants' surprise and dismay, however, the Office has refused to recalculate the PTA and instead insists that the Applicants missed the deadline to request reconsideration of the PTA. But the PTA allocation *could not have* been corrected until the Office corrected the filing date, which had already been requested. While the Applicants requested correction of the filing date four months before the issue fee was required to be paid, the Office did not take action to correct the filing date until three months after the patent issued. By refusing to recalculate the PTA following correction of the Office's mistake, the Office has unfairly stripped the Applicants of 390 days of PTA to which they are rightfully entitled.

Applicants submit that under these facts, it need not have filed a request under 37 C.F.R. 1.705(b), and that its December 19, 2011 Petition Under 37 C.F.R. 1.181 and 1.705 to accord the correct filing date and recalculate PTA should properly be considered as a timely petition under 37 C.F.R. 1.705(d). The Office's failure to act on Applicants' Request for a Corrected Filing Receipt did not come to light until the '585 patent issued and reflected an incorrect PTA calculation. Applicants timely filed a petition to correct the error and since the filing date has now been corrected, it is only appropriate that the PTA term be recalculated to reflect the properly accorded filing date. Applicants therefor request that the entire period of 1393 days of PTA due be accorded to the '585 patent.

Applicants acknowledge that they *could have* filed a renewed request for a corrected filing receipt, together with a corresponding request for recalculation of the PTA allocation in view thereof, prior to paying the Issue Fee. To the extent the Office believes that despite the facts set forth above, the rules nonetheless *require* Applicants to have filed such a request to obtain correction of the PTA due to this patent, Applicants further submit that simple fairness and equity dictate a suspension of the rules in this instance, because the circumstances that led to Applicants' loss of 390 days of patent term were entirely of the Office's making. The Office initially erred when it accorded an incorrect filing date to the application. The Office then compounded the error by failing to act on the Applicants' May 11, 2011 request that the filing date be corrected. Despite being placed on notice that the filing date accorded the '884 application was wrong, the Office proceeded to issue the '585 patent and relied on the erroneous filing date to calculate the period of PTA due to the patent. The Decision dismissing Applicants'

Petition deprives Applicants' right to an additional 390 days of patent term. The interests of equity require that the Office reconsider its position and, if necessary, suspend its rules so that the '585 patent can be accorded the full 1393 days of PTA that are due.

**Relief Requested**

Applicants hereby request that the Office recalculate the PTA of U.S. 8,039,585 based on the correct filing date – August 9, 2006. While the Applicants believe that no special consideration is due in order to effect this recalculation, Applicants further request that if necessary, the Director suspend the rules in order to effect this recalculation, as the equities are clearly are in the Applicants' favor.

Applicants do not believe any additional fees are due; however, if the Director disagrees, the Applicants hereby authorize the Commissioner to charge any fee deficiency or any additional fees associated with this Petition to Deposit Account No. 23-3050.

Date: April 17, 2012

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